

REMARKS/ARGUMENTS

The Office Action mailed August 23, 2006 has been received and reviewed. Claims 1 through 99 are currently pending in the application. Claims 21 through 42 and 59 through 99 have been withdrawn. Claims 1 through 20, and 43 through 58 stand rejected. Claims 1 and 43 have been amended.

35 U.S.C. § 102(b) Anticipation Rejections

Anticipation Rejection Based on U.S. Patent No. 5,686,317 to Akram et al.

Claims 1 through 5, 7 through 20, 43 through 47, and 49 through 58 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Akram et al. (U.S. Patent No. 5,686,317). Applicants respectfully traverse this rejection, as hereinafter set forth.

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *Verdegaal Brothers v. Union Oil Co. of California*, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). The identical invention must be shown in as complete detail as is contained in the claim. *Richardson v. Suzuki Motor Co.*, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

Applicants submit that the Akram reference does not and cannot anticipate under 35 U.S.C. § 102 the presently claimed invention of independent claim 1 and claims 2-5 and 7-20 depending therefrom, and independent claim 43 and claims 44-47 and 49-58 depending therefrom, because the Akram reference does not describe, either expressly or inherently, the identical inventions in as complete detail as are contained in the claims.

The Office Action alleges:

Regarding claim 1 []: Akram et al. discloses in figures 1E-6A, a contact pin assembly, comprising: a substantially planar substrate (12), a first contact pin (26) having a contact end (34) on a first side of the substrate (upper portion of element 12) and formed in place (it appears element 26 is formed in place with element 12) from a first portion of the substrate (12); and first compliant coupling structure (38, see figure 1G) to couple the first contact pin (26) in an orthogonally compliant orientation with the substantially planar substrate (12). (Office Action, p. 2).

Regarding claim 43: Akram et al. discloses in figure 1E-6A, a contactor card, comprising: a substrate (12) configured for attachment with a semiconductor tester and at least one contact pin (26) assembly, including: a substantially planar substrate (portion of 12), a first contact pin (12) formed in place from a first portion of the substrate (12); and

first compliant coupling structure (38, figure 1G) to couple the first contact pin (26) in an orthogonally compliant orientation with the substrate. (Office Action, p. 4).

Applicants respectfully disagree that the Akram reference anticipates Applicants' invention as claimed in independent claim 1 which reads:

1. A contact pin assembly, comprising:
a substantially planar substrate;
a first contact pin having a contact end on a first side of the substrate, the first contact pin ***configured physically independent from the substrate*** and formed in place and formed from a first portion of the substrate; and
first compliant coupling structure to couple the first contact pin in a substantially orthogonal orientation ***with the substantially planar substrate***. (Emphasis added.)

Furthermore, Applicants respectfully disagree that the Akram reference anticipates Applicants' invention as claimed in independent claim 43 which reads:

43. A contactor card, comprising:
a substrate configured for attachment with a semiconductor tester; and
at least one contact pin assembly, including:
a substantially planar substrate;
a first contact pin configured physically independent from the substrate and formed in place and formed from a first portion of the substrate; and
first compliant coupling structure to couple the first contact pin in a substantially orthogonal orientation ***with the substrate***. (Emphasis added.)

While the Office Action alleges that the Akram reference discloses Applicants' invention, Applicants' invention as presently claimed in amended independent claim 1, from which claims 2-5, 7-20 depends, and independent claim 43, from which claims 44-47 and 49-58 depend, includes the claim elements of "***a first contact pin [] configured physically independent from the substrate ... and first compliant coupling structure to couple the first contact pin ... with the [] substrate.***"

In contrast, the Akram reference discloses the alleged "substrate 12" having an integral profile disclosed as the alleged "first contact pin 26" with the further alleged "first compliant coupling structure 38" conformally applied over the alleged "first contact pin 26" and **not** "***to couple the first contact pin ... with the [] substrate***" as claimed in Applicants' amended independent claim 1. (See Akram figure 1G). Specifically, the Akram reference discloses:

Following the formation of the projections 26 and as shown in FIG. 1G, ***a mask layer 38 is formed on the substrate 12 and projections 26.*** A typical thickness for the mask layer 38 is about 500 .ANG. to 3000 .ANG.. The mask layer 38 can be formed of a material, such as silicon nitride (Si_3N_4), using a suitable deposition process such as CVD. (Akram, col. 7, lines 4-9; emphasis added).

Clearly, the Akram reference discloses formation of projections 26 on a substrate 12, however, the Akram reference does not disclose “***a first contact pin [] configured physically independent from the substrate ... and first compliant coupling structure to couple the first contact pin ... with the [] substrate***” as claimed by Applicants in amended independent claims 1 and 43. Therefore, the Akram reference **cannot** anticipate under 35 U.S.C. § 102 Applicants’ invention as presently claimed. Accordingly, Applicants respectfully request the rejections of amended independent claim 1, from which claims 2-5, 7-20 depends, and amended independent claim 43, from which claims 44-47 and 49-58 depend, be withdrawn.

35 U.S.C. § 103(a) Obviousness Rejections

Obviousness Rejection Based on U.S. Patent No. 5,686,317 to Akram et al. in view of U.S. Patent No. 6,778,406 to Eldridge et al.

Claims 6 and 48 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Akram et al. (U.S. Patent No. 5,686,317) in view of Eldridge et al. (U.S. Patent No. 6,778,406). Applicants respectfully traverse this rejection, as hereinafter set forth.

The nonobviousness of independent claim 1 precludes a rejection of claim 6 which depends therefrom because a dependent claim is obvious only if the independent claim from which it depends is obvious. See In re Fine, 5 U.S.P.Q.2d 1596, 1600 (Fed. Cir. 1988), see also MPEP § 2143.03. Therefore, the Applicants request that the Examiner withdraw the 35 U.S.C. § 103(a) obviousness rejection to dependent claim 6 which depends from allowable amended independent claim 1.

The nonobviousness of independent claim 43 precludes a rejection of claim 48 which depends therefrom because a dependent claim is obvious only if the independent claim from

which it depends is obvious. *See In re Fine*, 5 U.S.P.Q.2d 1596, 1600 (Fed. Cir. 1988), *see also* MPEP § 2143.03. Therefore, the Applicants request that the Examiner withdraw the 35 U.S.C. § 103(a) obviousness rejection to dependent claim 48 which depends from allowable amended independent claim 43.

CONCLUSION

Claims 1 through 20 and 43 through 58 are believed to be in condition for allowance, and an early notice thereof is respectfully solicited. Should the Examiner determine that additional issues remain which might be resolved by a telephone conference, he is respectfully invited to contact Applicants' undersigned attorney.

Respectfully submitted,



Kevin K. Johanson
Registration No. 38,506
Attorney for Applicants
TRASKBRITT
P.O. Box 2550
Salt Lake City, Utah 84110-2550
Telephone: 801-532-1922

Date: November 24, 2006
KKJ/mah:lmh

\\Traskbritt1\Shared\DOCS\2269-5865US\189188.doc